

## REMARKS

Claims 6, 10, 13, 18, 21, 22, 23, 26, 29, 42, and 82 stand rejected under 35 U.S.C. §103(a) as being anticipated by U. S. Patent No. 6,810,200 to Aoyama *et al.* ('Aoyama') in view of U. S. Patent No. 6,847,950 to Kamibayashi *et al.* ('Kamibayashi'). Claim 82 stands rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

To determine obviousness under 35 U.S.C. §103(a), "the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved."<sup>1</sup>

A telephone interview was held on August 6, 2008 between Examiner Syed Y. Hasan, Supervisory Primary Examiner Thai Tran, and applicant's representative Dmitry Andreev.

With respect to claims 6, 10, and 13, applicant's representative asked the Examiner to identify where in the relied upon reference there is a teaching of "erasing means for **erasing the contents from the [source] storage medium.**" The Examiner replied by referencing Aoyama, reference numeral S210 of Fig. 6 and Col. 6, lines 20-25. Applicant's representative stated that while the referenced passage of Aoyama taught "delet[ing] the music data . . . from the data storage unit 1071," Aoyama's Fig. 2 and description<sup>2</sup> clearly showed that the data storage unit 1071 is an intermediate data storage which is different from the first (source) storage claimed by the applicant in claims 6, 10, and 13, since in the context of claims 6, 10, and 13, the "first storage minimum" is defined by the claim element of "a playback means for reproducing contents recorded on a first storage minimum and outputting the reproduced contents." Thus, assuming arguendo that the apparatus depicted in Aoyama's Fig. 2 can be analogized to the apparatus of applicant's claims 6, 10, and 13, then in order to satisfy the claim limitation of "erasing means for erasing the contents from the [source] storage

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<sup>1</sup> *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007) quoting *Graham v. John Deere Co., of Kansas City*, 383 U.S. 1 (Sup. Ct. 1966).

<sup>2</sup> Aoyama, Col. 6 lines 10-20

medium,” Aoyama should have taught a means for erasing the contents of the source CD 1080, rather than the intermediate data storage unit 1071.

The Examiner replied by requesting that the applicant’s representative submit an amendment with a detailed argument of the issue.

Further with respect to claims 6, 10, and 13, applicant’s representative asked the Examiner to identify where in the relied upon reference there is a teaching of erasing the content from the source storage medium “when the output of the detection means indicates that the contents are copy-inhibited.” The Examiner replied that the prior art of record did not contain the quoted claim element. The applicant’s representative stated that it is the applicant’s position that the claim rejections of claims 6, 10, and 13 should be withdrawn at least for the reason of the prior art of record failing to teach or suggest the claim element of “the output of the detection means indicat[ing] that the contents are copy-inhibited.”

A concurrently filed Communication to Record Substance of Interview is incorporated herein by reference.

With respect to independent claim 6, the applicant respectfully asserts that the Examiner has at least failed to show where in the relied upon reference there is a teaching of an “erasing means for erasing the contents from the [source] storage medium.” Relative to the above claim limitation, in the outstanding Office Action the Examiner has made a reference to Aoyama<sup>3</sup>, Col. 10, lines 9-13, which teaches incrementing the counter of the number of recordings, and is absolutely silent as to deleting the contents. Even though, as indicated by the Examiner at the interview on August 6, 2008, Aoyama teaches “delet[ing] the music data . . . from the data storage unit 1071,”<sup>4</sup> Aoyama’s Fig. 2 and description<sup>5</sup> clearly shows that the data storage unit 1071 is an intermediate data storage which is different from the first (source) storage claimed by the applicant in claim 6, since in the context of claims 6, the “first storage

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<sup>3</sup> Office Action of July 21, 2008, page 5

<sup>4</sup> Aoyama, Col. 6, lines 23-25

<sup>5</sup> Aoyama, Col. 6 lines 10-20

minimum” is defined by the claim element of “a playback means for reproducing contents recorded on a first storage minimum and outputting the reproduced contents.” Thus, even assuming arguendo that the apparatus depicted in Aoyama’s Fig. 2 can be analogized to the apparatus of applicant’s claims 6, 10, and 13 (which applicant reserves the right to dispute), then in order to satisfy the claim limitation of “erasing means for erasing the contents from the [source] storage medium,” Aoyama would have had to teach a means for erasing the contents of the source CD 1080, rather than the intermediate data storage unit 1071. If the Examiner wishes to maintain rejection of claim 6 over the combination of Aoyama and Kamibayashi, the Examiner is respectfully requested to show where in the prior art of record there is a teaching of “erasing means for erasing the contents from the [source] storage medium.”

Further with respect to independent claim 6, the applicant respectfully asserts that in the outstanding Office Action the Examiner did not even attempt to show where in the relied upon reference there is a teaching of erasing the content from the source storage medium “when the output of the detection means indicates that the contents are copy-inhibited.” At the interview on August 6, 2008, the Examiner stated that the prior art of record did not teach the claim limitation of erasing the content from the source storage medium “when the output of the detection means indicates that the contents are copy-inhibited.”

Accordingly, the Examiner is respectfully requested to withdraw the claim rejection of independent claim 6 at least for the reason of the prior art of record failing to teach or suggest the claim elements of “erasing means for erasing the contents from the [source] storage medium” and “the output of the detection means indicat[ing] that the contents are copy-inhibited.”

Dependent claim 21 is believed to be allowable at least for its dependence on an allowable base claim 6, and for additional combination of elements the claim recites.

With respect to independent claim 10, the applicant respectfully asserts that the Examiner at least failed to show where in the relied upon reference there is a teaching

related to an “erasing means for erasing the contents from the [source] storage medium,” as discussed herein *supra*.

Further with respect to independent claim 10, the applicant respectfully asserts that in the outstanding Office Action the Examiner did not even attempt to show where in the relied upon reference there is a teaching of erasing the content from the source storage medium “when the output of the detection means indicates that the contents are copy-inhibited,” as discussed herein *supra*.

Accordingly, the Examiner is respectfully requested to withdraw the claim rejection of independent claim 10 at least for the reason of the prior art of record failing to teach or suggest the claim elements of “erasing means for erasing the contents from the [source] storage medium” and “the output of the detection means indicat[ing] that the contents are copy-inhibited.”

Dependent claims 26, 29, 42, and 82 are believed to be allowable at least for their dependence on an allowable base claim 10, and for additional combination of elements the claims recite.

With respect to independent claim 13, the applicant respectfully asserts that the Examiner at least failed to show where in the relied upon reference there is a teaching related to an “erasing means for erasing the contents from the [source] storage medium,” as discussed herein *supra*.

Further with respect to independent claim 13, the applicant respectfully asserts that in the outstanding Office Action the Examiner did not even attempt to show where in the relied upon reference there is a teaching of erasing the content from the source storage medium “when the output of the detection means indicates that the contents are copy-inhibited,” as discussed herein *supra*.

Accordingly, the Examiner is respectfully requested to withdraw the claim rejection of independent claim 13 at least for the reason of the prior art of record failing to teach or suggest the claim elements of “erasing means for erasing the contents from

the [source] storage medium” and “the output of the detection means indicat[ing] that the contents are copy-inhibited.”

Dependent claim 22 is believed to be allowable at least for its dependence on an allowable base claim 13, and for additional combination of elements the claim recites.

With respect to the claim rejections argued by the applicant herein *supra*, the applicant's selective treatment and emphasis of independent claims of the application should not be taken as an indication that the applicant believes that the Examiner's dependent claim rejections are otherwise sufficient. Applicant expressly reserves the right to present arguments traversing the propriety of the dependent claim rejections later in the prosecution of this or another application.

Further with respect to the claim rejections argued by the applicant herein *supra*, while the applicant herein may have highlighted a particular claim element of a claim for purposes of demonstrating insufficiency of the examination on the part of the Examiner, the applicant's highlighting of a particular claim element for such purpose should not be taken to indicate that the applicant has asserted an argument in support of patentability that a particular claim element constitutes the sole basis for patentability out of the context of the various combinations of elements of the claim or claims in which it is present. The applicant maintains the right here forward to assert that each claim is patentable by reason of any patentable combination recited therein.

To reduce issues for consideration and expedite allowance, applicant has cancelled without prejudice or disclaimer claims 18 and 23. As it is emphasized that such cancellation is without prejudice or disclaimer, applicant reserves the right to pursue claims directed to the subject matter of the canceled claims in a related application (e.g., a continuing application).

The Examiner will note that the applicant has amended claim 82 to address the 35 U.S.C §101 rejection. It is believed that in the amended form claim 82 is directed to a statutory subject matter under MPEP §2106.01(I).

No amendment presented herein contains new matter.

Accordingly, in view of the above amendments and remarks, the applicant believes all of the claims of the present application to be in condition for allowance and respectfully request reconsideration and passage to allowance of the application.

If the Examiner believes that contact with the applicant's attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call the applicant's representative at the phone number listed below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to deposit Account No. 50-0289.

Dated: August 8, 2008

Respectfully submitted,

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